

wrapping, wrapping a plastic wrap in a helical manner onto the rotating supported roll, said plastic wrap being dispensed from a plastic wrap dispenser incorporated into the wrapper dispensing system.

7.-19. (canceled)

20. (previously presented) A method in accordance with claim 1, wherein the roll of web material is formed from paper and the wrapper is formed from paper.

21. (previously presented) A method in accordance with claim 1, wherein the wrapping is wound in a stagewise overlapping wrapping in a slightly helical manner onto the roll.

#### REMARKS

Claims 1-5 and 20-21 are now rejected under 35 U.S.C. §103(a) as being unpatentable over Hooper et al. (U.S. Patent 5,533,321) in view of Lancaster et al. (U.S. Patent 4,553,374), while claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hooper et al. '321 in view of Pienta et al. (U.S. Patent 6,347,498). The Examiner asserts that it would be obvious to one skilled in the art to combine the lateral movement of the Lancaster et al. '374 roll station with the wrapper dispensing and roll rotation stations of Hooper et al. '321 to arrive at the claimed invention.

However, Applicant respectfully submits that there must be demonstrated some teaching or motivation in Lancaster et al. to transform the Hooper et al. wrapper dispensing station as suggested by the Examiner. As such teaching or motivation clearly does not exist, Applicant respectfully submits that the Examiner is applying improper hindsight.

The Examiner has admitted that Hooper et al. fails to teach the process step of moving the roll rotation station laterally in an axial direction relative to the wrapper dispensing system. The Examiner also refers to Lancaster et al. as providing the missing teaching, i.e., "*Lancaster '374 teaches the process step of laterally moving a roll station '31, 32, 33' in an axial direction relative to the wrapper dispensing system during the dispensing step for a purpose of wrapping*".

*the entire length of wrapper in a slightly helical manner". However, the Examiner's assertion is misplaced and fails to meet the description of the Lancaster et al. '374 teaching. Lancaster et al. comprises a ring wrapping apparatus 30, comprising a feed conveyor 31, a wrap and load conveyor assembly 33, a film dispenser 35, a cutting mechanism 37, a takeoff conveyor 32, and a positionable conveyor assembly 150." (Column 7, lines 27-31). There simply is no equivalent or analogous roll rotation station in Lancaster et al. '374 as suggested by the Examiner. Instead, in Lancaster et al., "loads (rolls) are fed lengthwise by a conveyor through a rotating wrapping apparatus having a film web stretching mechanism and film dispensing mechanism" (Column 5, lines 35-38). In Lancaster et al., loads (rolls) are non rotating and conveyors are totally different from the roll rotation station of the present application. The "Rotatable Film Wrapping Apparatus For Cylindrical Loads" as the Lancaster et al. reference is titled, is in general, also totally different from the dispenser of the claimed invention.*

Accordingly, Applicant respectfully submits that a prima facie case of obviousness has not been successfully established. In addition, in order to establish a case of prima facie obviousness there must also be shown a motivation to combine the teachings of the cited references, namely Hooper et al. and Lancaster et al. To that end, some suggestion of the desirability to combine the references must be found and demonstrated in the references. This burden cannot be satisfied by simply asserting that the modification would have been "well within the ordinary skill of the art."

As the CAFC stresses for a § 103 rejection to stand, the Examiner is required to show **with evidence** the motivation, suggestion or teaching of the desirability of making the specific combination at issue. That evidence is required to counter the powerful attraction of a hindsight-based obviousness analysis. See, for example, *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433 (Fed. Cir. 2002) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"). It is respectfully submitted that this involves more than a mere bald assertion that it would be obvious to combine the cited references. With respect, the Examiner has failed to indicate why one of ordinary skill in the art would be motivated to combine the teachings of Hooper et al. and

Lancaster et al. to arrive at the claimed invention. *In re Lee* requires that the record must state with particularity all the evidence and rationale on which the PTO relies for a rejection and sets out that it is necessary to explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. As Lancaster et al. fails to teach or reasonably suggest a fundamental aspect of the claimed invention, namely the process step of moving the roll rotation station laterally in an axial direction relative to the wrapper dispensing system, Applicant respectfully submits that one skilled in the art would not be motivated to arrive at the claimed invention through the teachings of Lancaster et al. in combination with Hooper. There simply is no reason why one skilled in the art would be motivated to transform the Hooper et al. structure into a structure having a roll rotation station that is moved laterally in an axial direction relative to the wrapper dispensing system as simply set forth in the claimed invention.

Accordingly, Applicant respectfully submits that one skilled in the art would not be taught or reasonably motivated to arrive at the claimed method for packaging rolls of web material such as rolls of paper, the method comprising the steps of providing a wrapper dispensing system for dispensing wrapping onto a roll of web material, said wrapper dispensing system comprising a wrapper dispensing station and a wrapper dispensing means, supporting a roll of web material on a roll rotation station, rotating said roll rotation station with said roll of web material supported thereon, said wrapper dispensing system remaining stationary relative to said rotating supported roll, dispensing wrapping onto the rotating supported roll from said wrapper dispensing station via said dispensing means so that the wrapping is wound so as to form on said rotating supported roll either a centered wrapping or a stagewise overlapping wrapping, and moving the roll rotation station laterally in the axial direction of the rotating supported roll relative to the wrapper dispensing system during the dispensing step.

Accordingly, the Examiner is respectfully requested to withdraw the §103(a) rejection to claim 1 and the remaining claims through dependency.

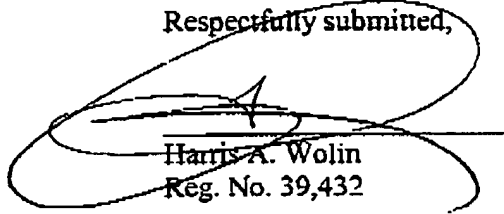
For the foregoing reasons, reconsideration is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1-6, 20 and 21, consisting

of independent claim 1 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



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